

RESPONSE under 37 C.F.R. § 1.116
U.S. Appln. No. 09/745,923

REMARKS

By this amendment, Applicant cancels claims 17-20 and adds new claims 21-22 thus claims 1-16 and 21-22 are all the claims pending in the application and stand finally rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and following remarks.

CLAIM REJECTIONS.

35 U.S.C. § 102

Claims 11-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,898,933 to Kaschke. Applicant respectfully traverses this rejection for the following reasons.

Applicant previously traversed this rejection primarily on the grounds that Kaschke fails to teach or suggest disabling a communication module as recited in claim 17 or disabling the communication module from receiving recited in independent claim 11. As Kaschke only discloses changing modes of operation in response to the antenna position and not disabling a communication module as recited in claims 1-20, Kaschke cannot anticipate Applicant's claims.

Notwithstanding, by this amendment, Applicant amends the claims to further distinguish over the cited reference. Namely, the communication module of independent claim 11 is amended to recite one or more springs to assist in extending at least a portion of the antenna module from the communication module. Since Kaschke fails to teach or suggest this feature, claim 11 and the claim depending there from cannot be anticipated and the Examiner is respectfully requested to reconsider and withdraw the §102 rejections of record. Support for the claim amendments may be found on page 7, lines 1-11.

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35 U.S.C. § 103

Claims 1-10 were again rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,336,039 to Usui in view of Kaschke. Applicant respectfully traverses this rejection for the following reasons.

It is respectfully submitted that a *prima facie* case of obviousness has not been established since: (i) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings as suggested in the Office Action; and (ii) even when combining the cited references as suggested, the prior art references when combined fail to teach or suggest each and every claim limitation. Without both of these elements, a *prima facie* case of obviousness is not established and a rejection under 35 U.S.C. § 103(a) is improper (MPEP 2143).

(i) **THERE IS NO MOTIVATION TO COMBINE REFERENCES**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the instant case the Office Action alleges it would be obvious to combine the position responsive antenna disclosed by Kaschke with the Usui system "to provide the convenient for user operation and protection from accidental activation of exposed control keys." (2/11/04 Final Office Action pg. 3). Again, Applicant points out that Usui already has a solution to prevent accidental activation of exposed control keys (e.g., dial button 121 or sheet switch 121a); see AND circuit 168; Fig. 9 and col. 10, ll. 38-65 and thus this particular motivation to combine is invalid.

As far as the rational for substantially redesigning the Usui system with the position responsive antenna disclosed by Kaschke to allegedly provide "convenient operation," Applicant

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respectfully submits this conclusory, over-generalized and unsupported speculation is not an objective reason sufficient to establish *prima facie* obviousness. See, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Applicant further submits that it is entirely unsupported speculation that the on-hook/off-hook position responsive antenna on the telephone disclosed by Kaschke would make the PMCIA card of Usui any more convenient to use. Respectfully, it appears the sole motivation for combining Usui and Kaschke is a piecemeal attempt to reconstruct Applicant's claims based on improper hindsight of the present disclosure.

Since there is no proper motivation for combining the Kaschke with Usui, the rejection of Applicant's claims under 35 U.S.C. § 103(a) is improper and should be withdrawn.

(ii) THE RESULTING COMBINATOIN FAILS TO TEACH THE CLAIMED LIMITATIONS

Even assuming that it would be proper to combine the references as suggested by the Office Action (*arguendo*), the resultant combination would still fail to teach or suggest *an antenna unit adapted to disable a communication module when in a first position* as recited in claims 1-10. Further, Kaschke and Usui, taken alone or in any combination fail to teach or suggest a spring for extending an antenna unit or module.

Because the suggested combination of prior art references is improper and because taken alone or in combination the prior art references fail to teach or suggest each and every claimed limitation, Applicant respectfully submits there is no *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, reconsideration and withdrawal of the §103 rejection of record is respectfully requested.

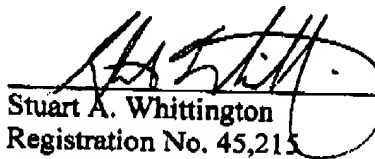
CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is

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kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to **Deposit Account # 50-0221.**

Respectfully submitted,


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